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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/726,465	12/02/2003	Donald B. McDugle	P114519	5858
22931 7590 03/27/2007 HUGHES LAW FIRM, PLLC PACIFIC MERIDIAN PLAZA, SUITE 302 4164 MERIDIAN STREET BELLINGHAM, WA 98226-5583			EXAMINER SWINEHART, EDWIN L	
			ART UNIT	PAPER NUMBER
			3617	
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		03/27/2007	PAPER	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/726,465	<b>Applicant(s)</b> MCDUGLE ET AL.	
	<b>Examiner</b> Ed Swinehart	<b>Art Unit</b> 3617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 20 March 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-64 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-64 is/are rejected.
- 7) ☒ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 3/20/2007 has been entered.

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 30-38 are rejected under 35 U.S.C. 102(b) as being anticipated by Applicant's disclosed Offer for Sale of the claimed invention.

Applicant's disclosed device offered for sale more than one year before filing shows the invention as claimed. The central thruster section with a pair of extensions for preventing ambient air from entering the thruster are clearly shown in the detailed drawings provided, and discussed in the accompanying Declaration. The claimed dimensions are clearly shown in the provided evidence.

4. Claims 1-29 and 39-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant's disclosed Offer for Sale of the claimed invention in view of Den Ouden.

Art Unit: 3617

Applicant's disclosed for sale device was mounted below the bottom edge of the transom, and therefore would not be clear of the water during high speed maneuvering, and therefore would present a high degree of drag, as would be known to the ordinary routineer working in the art.

Den Ouden teaches the positioning of such a thruster so that it is clear of the water when the boat is operated at high speed.

It would have been obvious to one of ordinary skill in the art at the time of the invention to raise the position of the thruster disclosed by Applicant to a position as taught by Den Ouden, such that it would clear the water when the boat is at high speeds.

Such a combination would have been desirable at the time of the invention so as to provide for reduced drag.

Re claim 12, as shown in the provided evidence, the extent is "about" 25% or 30% as claimed.

Re claim 16, the illustrated width is considered to be "about" 40% as claimed. Furthermore, it would have been well within the level of skill of the ordinary routineer working in the art at the time of the invention to size the device as claimed. For example, when placing the device on boats of various widths, such sizing would provide no unexpected results.

5. Claims 49-64 are rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant's disclosed Offer for Sale of the claimed invention in view Stallman.

Art Unit: 3617

Applicant's disclosed Offer for Sale of the claimed invention, prior to the critical date of 11/6/2001 did not incorporate a flange extending about the extension inlet as claimed.

Stallman teaches a flange extending about an inlet.

It would have been obvious to one of ordinary skill in the art at the time of the invention to provide a flange to Applicant's disclosed device Offered for Sale as taught by Stallman.

Such a combination would have been desirable so as to prevent the entry of air into the inlet.

6. Applicant's arguments filed 9/11/2006 have been fully considered but they are not persuasive.

7. The Declarations filed on 3/20/2007 and 9/11/2006 under 37 CFR 1.131 or 1.312 have been considered but is ineffective to overcome the Offer for Sale reference.

The declarations are insufficient to show experimental exception to 102(b) on-sale bar. Firstly, there is no nexus between the invention as claimed, and the thruster as discussed in the declarations. The phrases "and to my knowledge of patent law" and "reads upon" render the statement attempting to show a nexus inadequate. Secondly, applicant failed to maintain control over the so-called "experimental use", as the declaration states that Mr. Murch "drove the boat away", and applicant was "not able to reach him". Applicant's attempts to contact the purchaser are noted, however an attempt to maintain control over an experimental sale is not the same as maintaining control itself. Applicant makes no mention of the informing of the purchaser of the so-

Art Unit: 3617

called experimental use. It is not enough that applicant regarded the sale as experimental, the purchaser must be made aware as well, and that diligent follow up and monitoring is required.

In response to applicant's arguments, changes/modifications to the invention in response to such experimental use were NOT made. Apparently the installation was faulty and it leaked which required repair, and the motor had to be rebuilt/replaced.

Neither of which constitute part of the claimed invention. Applicants attempt at contacting the purchaser does not satisfy the requirement of following up and monitoring in a diligent fashion. A period of five months is not considered acceptable.

Applicant's argument that other changes were made to address water flowing up around the housing are not supported by the declaration.

Applicant further argues that the design was changed due to such experimental sale test results.

In response, at least claims 30-38 are directed to the original on-sale design, and do not contain the changes as argued. Such is clear evidence of reduction to practise which constitutes an on-sale bar.

8. This is an RCE of the current application, and all claims are drawn to the same invention claimed and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered earlier. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

Art Unit: 3617

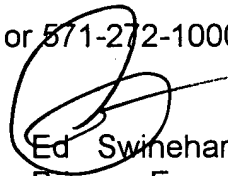
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ed Swinehart whose telephone number is 571-272-6688. The examiner can normally be reached on Monday through Thursday 6:30 am to 2:00 pm..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Samuel Morano can be reached on 571-272-6684. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3617

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Ed Swinehart  
Primary Examiner  
Art Unit 3617